



0. *Enclosure*
AUG 06 2003
TC 1700

Docket No.: 2232-146

**NOTICE OF APPEAL FROM THE PRIMARY EXAMINER
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of A. E. COLVIN, JR.

Serial No.: 09/920,627

Filed: August 3, 2001

For: DETECTION OF ANALYTES IN AQUEOUS ENVIRONMENTS

Group Art Unit: 1743

Examiner: M. Cole

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision of the Examiner dated May 6, 2003 rejecting the following claims: 1-4, 6-7, 10-12, 14-17, 19-20, 23-25, 27-30, 32-33, 36-38, 40-44, 46-51, 53-56 and 58.

Applicant claims small entity status. Therefore, the fee for this Notice of Appeal is \$160.00.

A check for \$160.00 is enclosed.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-2135. An additional copy of this Notice is enclosed herewith.

Respectfully submitted,

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Enclosure(s): Response; Fee Transmittal; Check
2232-146.noa

Memo of Record: Skip Colvin Contact From Henry Hu - Evening May 21, 2003
Memo Date: May 22, 2003 sc
Regarding: Water Soluble Polymer Patent(s) at PTO and Invention

Last evening, May 21, 2003, Henry Hu, a former SMSI employee, called my house and asked to speak with me. I was unable to take the call immediately and Henry asked my wife to have me return his call however late it might be and provided a telephone number (301-869-6448 his home). Shortly thereafter (about 10:30pm) I returned his call. I anticipated a request for employment recommendation.

Begin telephone conversation....

I asked how he was doing, told him that it was good to hear from him, and asked what could I do for him. Henry told me that he had called because of an issue at the PTO regarding SMSI's water soluble polymer patent applications (he used the formal name of the applications - which I do not recall at the moment). At first I was not connecting this person with this subject and thus somewhat confused and asked what he was talking about. I said that the company had some number of patents in process at the patent office and what was he talking about? He said the patents he was speaking of were ones on which I was the sole inventor and these were questioned at the PTO. That he had met with the PTO on this issue, and as a result, the PTO had checked my background and found out that I was not an organic chemist, and not being an organic chemist, I could not have run these reactions required to make these inventions. Henry was not direct in saying that he believed himself to be an inventor, but instead through several iterations made the point that I could not have been the sole inventor because I was not an organic chemist and needed to be an organic chemist to have run these reactions - and although not direct, I speculated from his explanation, by default he saw himself as the co-inventor. I responded that I was a biochemist and understood exactly what I was doing - but stopped there since I was beginning to fully understand the nature of the phone call after about the first 10 minutes of listening (it was difficult at this hour of the evening to get re-focused on such work-related issues so my approach was to listen and try to understand him clearly and take notes), and therefore I decided not to enter into debate on this. Henry explained that to not list an inventor is bad and that all six patents would be lost to the company and that I would screw up the company by doing this. I asked what 6 patents was he speaking of? - to which he replied one original which he said was abandoned, one CIP, and 4 divisionals, and that all six of these applied to this situation. He said (repeatedly) that I needed to change it right away because the next patent would (I thought he said issue?) soon and this was urgent because if it finalized, then it would be too late to change and this would ruin the patents as enforceable. Henry did 90% of the talking through this point and my primary responses had to do with asking him to repeat some things because he is difficult to understand (language). He spoke rapidly and seemed

excited although hard to tell with him how much is his normal way of speaking. He was definitely wanting to be persuasive and typically would repeat my name twice at the beginning of a point such as "Skip, Skip, you need to change this right away".

Henry advised several times that the PTO had checked my background and therefore did not think I could have been the inventor. There was much repeating of himself with emphasis during the first ten minutes or so of the telephone call but the content was completely that the PTO had checked my background and that since I was not an organic chemist, and there was no organic chemist on the patent, that I could not have run these reactions.

I then asked him to explain again how he came to call me about this as opposed to the patent office notifying our patent firm, because our patent firm was our interface with the PTO, and that I did not understand how this works this way. Henry repeated that he had met with the PTO and that the PTO had asked him to call me directly about it. I re-asked that the PTO had told him to call me directly, since that seemed really strange to me that this would work this way, and Henry said yes, they had told him to call me directly. That I needed to add him as inventor, and that we could work this out between the two of us. I said that it seemed strange to me that the PTO would work this way but that I had no direct knowledge myself of procedure – but that first thing in the morning I would take his information to SMSI and report, and that we would have our patent attorneys take a look. I explained that I thought the patent applications were fine as is but I told him that he could be sure the company would review the matter and do the right thing whatever it was. He said again then that 'you need to change it to correct inventorship'. I told him again that I would see to it that his information would go directly to our patent firm in the morning. I said that our attorneys would be informed of all of this and they would know what the best thing to do was. Henry said that I did not need attorneys for this, that the attorneys did not know who the inventors were and that I had to change it, and that it needed to be done soon. He said again that we can work this out between the two of us. I told him that there was no way anything like that would happen but assured him that our patent counsel would always do the right thing as would SMSI on any issue. I asked if, in case our patent counsel needed to call him directly to ask questions or get clarification, could he provide me with a work telephone number. Henry said no, that he could not be called at work. I asked where did he work. Henry said that he could not tell me where he worked. I asked if he worked in a secret place (joking). He said he could not tell me where he worked and that our patent attorney could not call him in the day but could call him at night at home. I explained that these guys work in the daytime like we do so how could they contact him. He said they could call his home telephone number (as I did) and he would call them back. Henry reiterated that I did not really need attorneys for this and that I could just tell them to add an inventor to do the right thing. I replied again that there was no way this would work through anyone other than our patent firm as of tomorrow morning, but again assured him that they would look

into and do the right thing whatever that proved to be. I said that patent attorneys have tests and can examine for inventorship and the means to determine correctly who is an inventor and best to leave it to them. Henry was not sounding in agreement but our conversation was winding up.

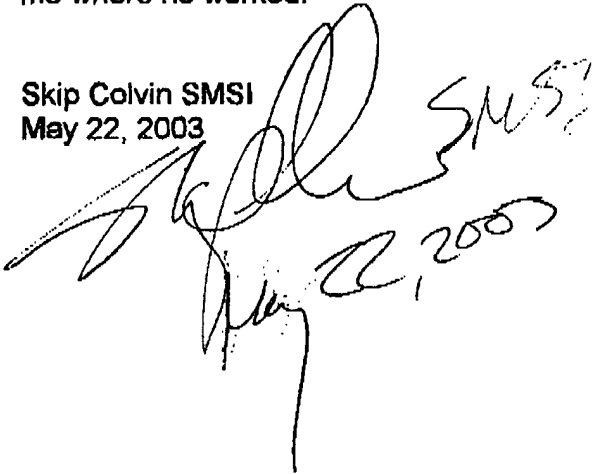
We seemed to be done so I asked how his two kids were doing. He told me that oldest was now in grad school at MIT and the youngest was now at Berkeley as an undergraduate and both doing well. I told him that he had a lot to be proud of with those kids. Henry also told me that he had talked to Jenny last week, another former SMSI employee, and that she was well. Although I thought we were closing, Henry pretty much went right back to hammering away on his point again that I needed to fix this right way, and in his most earnest voice, "Skip, Skip, we can take care of this just between us". I reiterated for yet another time that although no way anything would happen that way, it would be looked at and the company would do the right thing. I thanked him for calling and said goodnight.

End of telephone conversation.....total elapsed time estimated about 15 and perhaps as long as 20 minutes

Note: both Henry and Jenny were former employees who worked directly for me. Henry left SMSI September 15, 2000 and Jenny left on December 15, 1998.

Note: about one year ago SMSI received an employment verification document indicating that Henry applied for a job with the PTO. Remembering this, although I did not say so during our telephone conversation, I believed and expected during the phone conversation that Henry was a PTO employee. Henry at no time however said that he worked for the PTO and stated that he could not tell me where he worked.

Skip Colvin SMSI
May 22, 2003



SMSI
May 22, 2003